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In re Application of :  
FLORES *et al* :  
U.S. Application No.: 10/563,095 :  
PCT No.: PCT/EP04/07062 :  
Int. Filing Date: 30 June 2004 :  
Priority Date: 01 July 2003 :  
Attorney Docket No.: 1541 0007US :  
For: METHOD FOR THE PRODUCTION OF :  
VALVE SEATS, AND VALVE :

## DECISION

This decision is in response to the papers filed 11 January 2008 which are treated as a petition to withdraw the holding of abandonment. No fee is required.

## BACKGROUND

On 14 September 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. A two-month time limit in which to respond was set with extensions of time available pursuant to 37 CFR 1.136(a).

On 03 December 2007, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed for failing to respond to the Form PCT/DO/EO/905 mailed 14 September 2006.

On 11 January 2008, applicants filed the subject petition which was accompanied by, *inter alia*, an executed declaration; authorization to charge the surcharge fee to Deposit Account No. 50-1030; a copy of practitioner's docket record of 14 November 2007 and a typewritten copy of this docket record.

## DISCUSSION

A review of the above-captioned application shows that a timely response to the Form PCT/DO/EO/905 mailed 14 September 2006 was not provided. Accordingly, the above-captioned application was properly abandoned.

Applicants claim that the Form PCT/DO/EO/905 was never received and submitted a petition under 37 CFR 1.181. This is treated as a petition to withdraw the

holding of abandonment based upon nonreceipt of an Office action. No fee is required for this petition.

### **Office Action Not Received**

The showing required to establish the failure to receive an Office communication consists of: (1) a statement declaring that the Office communication was not received by the practitioner; (2) a statement attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received; and, (3) a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioners' statement. See MPEP § 711.03(c).

In the petition, counsel attests that items (1) and (2) were satisfied.

With regards to item (3), petitioner submitted a copy of the docket record of 14 November 2007 and a typewritten copy of this docket record. Counsel explains that "the typed copy is an accurate and true representation of the docket record. Clearly, docket number 1541 007US is missing."

Section 711.03(c) of the MPEP discusses the docket record requirement and states, in part:

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a

copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

A review of the evidence shows that the docket record provided does not contain any information on the docket number in question for 14 November 2007. However, counsel must explain how their docketing system works and show that it is sufficiently reliable to ensure that all deadlines are met.

Moreover, if there is any other corroborating evidence that supports applicants' claim that the Form PCT/DO/EO/905 mailed 14 September 2006 was not received, applicants should provide this in any renewed petition. Such evidence could be in the form of the law firm mail log from 14 September 2006 to 14 November 2006, a copy of a master computer docket record, and declarations by persons responsible for maintaining the docket.

Therefore, applicants have not met all of the requirements required to establish nonreceipt of an Office action.

### **CONCLUSION**

For the reasons discussed above, applicants' petition to withdraw the holding of abandonment is **DISMISSED** without prejudice.

The subject application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are authorized.

It is noted that the declaration submitted with the subject petition is only a partial declaration and is not in compliance with 37 CFR 1.497(a) and (b). The declaration consists of 4 pages, *i.e.*, pages 1, 2, and two page 3's. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. By providing only a partial declaration for some co-inventors, it is not clear what inventive entity was listed on the declaration signed by each co-inventor.

Applicants must provide a complete copy of each declaration signed by each inventor.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in cursive script that reads "James Thomson".

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